

EXHIBIT C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Shigeru Yokono et al.
Appl. No.: 10/016,242
Conf. No.: 7869
Filed: October 30, 2001
Title: DOWNLOADING SYSTEM
Art Unit: 2155
Examiner: Tran, Philip B.
Docket No.: 112857-250

Mail Stop RCE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT AFTER FINAL

Sir:

In reply to the final Office Action dated November 27, 2006 please amend the above-identified patent application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks begin on page 4 of this paper.

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

Claims 1-26 (canceled).

Claim 27 (currently amended): A portable recording medium storage device used with a downloading apparatus for recording and physically transporting digital data, comprising:

an storage assembly have a predetermined shape and being adapted to be received by or loaded into the data downloading apparatus of a data downloading system; and

a main recording surface have at least two different recording areas including at least a first non-rewritable recording area in which is recorded download identification information for designating information to be downloaded to the recording-medium storage device when the storage device recording-medium is loaded in the a data downloading system, and medium identification information for identifying the recording-medium storage device[[:]] as permitted in the downloading system, and a second rewritable recording area for recording digital data identified by the download information,

wherein the digital data is automatically recorded on the recording-medium portable storage device by the data recording downloading system when the portable storage device is loaded into the data downloading apparatus and the medium identification information is recognized as being authorized for recording the digital data.

Claim 28 (currently amended): The A-recording medium device according to claim 27, further comprising a third area of the main recording surface in which information can be recorded as use record information about regarding various processing[[:s]] executed by the downloading system when the recording medium is loaded in the downloading system to which the recording medium is adapted.

Claim 29 (currently amended): The A-recording medium device according to claim 27, further comprising a fourth area of the main recording surface in which information can be

recorded as fee record information of fees charged with respect to various processings executed by the downloading system when the recording medium is loaded in the downloading system to which the recording medium is adapted.

Claim 30 (canceled)

Claim 31 (new): A method of using a portable storage device in a data downloading system for recording and physically transporting digital data, the method comprising:

recording in a first non-rewritable recording area of the portable storage device download identification information for designating information to be downloaded to the storage device and medium identification information identifying the storage device as permitted in a data downloading apparatus of the data downloading system;

loading in the data downloading apparatus the portable storage device, the portable storage device having a predetermined shape adapted to be received by or loaded into the data downloading apparatus; and

automatically downloading or recording in a second rewritable recording area digital data identified by the download information,

wherein the digital data is recorded on the storage device by the data downloading system when the medium identification information is authorized by the data downloading apparatus for recording the digital data.

32. (new) The method of claim 31, further comprising recording in a third area of the portable storage device use record information regarding various processing executed by the data downloading system when the portable storage device is loaded in the data downloading system.

33. (new) The method of claim 31, further comprising recording in a fourth area fee record information of fees charged with respect to various processings executed by the data downloading system when the portable storage device is loaded in the data downloading system.

REMARKS

This Response is submitted in reply to the final Office Action dated November 27, 2006, issued in connection with the above-identified application. Claims 27-30 are presently pending in the application. With this Response, claims 27-29 have been amended, claim 30 has been canceled, and claims 31-33 have been added. No new matter has been introduced as a result of this Response; thus, favorable reconsideration is requested.

Claims 27-29 stand rejected under 35 U.S.C. §101 for being directed to non-statutory subject matter. The Examiner alleges that the claims appear to be abstract ideas rather than a practical application of the idea. The Applicants have amended the claims to more clearly point out that they are directed to *an apparatus and not an abstract idea*. In this case, a “portable storage device” having novel structure. Thus, the claims as amended are now believed to fall into one or the four enumerated categories of patentable subject matter under 35 U.S.C §101.

Claims 27-28 stand rejected under 35 U.S.C. §102(e) as being anticipated by Nakashima et al. (U.S. Patent No. 5,930,825, hereafter “Nakashima”); and claims 29-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nakashima in view of Schoen et al. (U.S. Patent No. 5,592,511, hereafter “Schoen”). The Applicants respectfully traverse these rejections.

The Applicants have amended independent claim 27 to clarify that the apparatus of the present invention is directed to a portable storage device used with a downloading apparatus for recording and physically transporting digital data, which includes the following structural features:

1) an storage assembly have a predetermined shape and being adapted to be received by or loaded into the data downloading apparatus of a data downloading system; and

2) a main recording surface have at least two different recording areas: a) a first non-rewritable recording area in which is recorded download identification information for designating information to be downloaded to the storage device when the recording medium is loaded in the data downloading system, and medium identification information identifying the storage device as a permitted device; and b) a second rewritable recording area for recording digital data identified by the download information. An important feature of the present invention is that the digital data is *automatically* recorded on the portable storage device when the portable storage device is loaded into the data downloading apparatus and the medium

identification information is recognized as being authorized for recording digital data (see, Applicants' Application, page 4, line 1-page 5, line 8; Fig. 4; and Figs. 6A-6C).

In the Office Action, the Examiner relies on Nakashima for disclosing all the features recited in independent claim 27. However, Nakashima is directed to a method of protecting software from being unlawfully copied from a disc (storage device) to a computer system using medium ID information. More specifically, if an optical disk (containing software/data) is indicated as an original, the data on the optical disk is executed for downloading *from the optical disk to, for example, a PC*. However, if the optical disk is indicated as a copy, then a warning or other message is displayed and the copy operation is halted (see, Nakashima, col. 14, line 60 – col. 15, line 43).

Thus, the medium ID information disclosed in Nakashima is used for identifying data to be downloaded *from the portable storage device to a system or PC. Additionally, nothing about the downloading of information appears to be automatic when the portable storage device is loaded*. For example, after the optical disc is loaded, the user is required to enter "SAMPLE.TXT" from a keyboard. The host then acquires the necessary application program. (see col. 7, lines 12-19). Therefore, Nakashima does not disclose the claimed second recording area for recording digital data identified by download information; mainly, because no information is downloaded from the PC to the optical disk. Additionally, the downloading of information (albeit from the optical disk to the PC) is not automatic.

Moreover, Schoen does not overcome the deficiencies noted above in Nakashima. Therefore, even if one of ordinary skill in the art were to combine the teachings of Nakashima and Schoen, the combination still would not teach or suggest all the features recited in at least independent claim 27 (as amended).

Independent claim 27 is distinguished over the cited references for at least the reasons noted above. Likewise, dependent claims 28-29 are also distinguished over the cited references based on their dependency on independent claim 27. Additionally, new claims 31-33 are distinguished over the cited references for similar reasons.

In light of the above, the Applicants respectfully submit that all the pending claims are in condition for allowance. Thus, a timely Notice of Allowance is respectfully requested. The Director is authorized to charge and credit Deposit Account No. 02-1818 for any additional fees

associated with the submission of this Response, including any time extension fees. Please reference docket number 112857-250.

Respectfully submitted,
BELL, BOYD & LLOYD LLP

BY 

Thomas C. Basso
Reg. No. 46,541
Cust. No. 29175

Dated: January 30, 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Shigeru Yokono et al.
Appl. No.: 10/016,242
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Filed: October 30, 2001
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Docket No.: 112857-250

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT TRANSMITTAL LETTER

Sir:

Submitted herewith is an Information Disclosure Statement for consideration in the above-identified application. In accordance with the provisions of 37 C.F.R. 1.56, 37 C.F.R. 1.97, and 37 C.F.R. 1.98, Applicants request that a citation and examination of the references cited on the enclosed PTO-1449 form be made during the course of examination of the above-identified application for United States patent. Pursuant to 37 C.F.R. 1.98, copies of any cited foreign patent documents and non-patent documents are enclosed.

This Information Disclosure Statement is submitted:

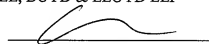
- ☐ Within three months of filing of a national application; within three months of the date of entry of the national stage as set forth in 37 C.F.R. §1.491 in an international application; before the mailing date of a first Office Action on the merits, or before the mailing of a first Office Action after the filing of a Request for Continued Examination.
- ☐ After the period specified above, but before the mailing date of a Final Action under 37 CFR 1.113, a Notice of Allowance under 37 CFR 1.311, or an Action that otherwise closes prosecution in the application and is accompanied by one of:
 - ☐ Payment of the fee set forth in 37 CFR 1.17(p); or
 - ☐ The certification specified in 37 CFR 1.97(e) follows.
- ☒ After the mailing date of a Final Action under 37 CFR 1.113, a Notice of Allowance under 37 CFR 1.311, or an Action that otherwise closes prosecution in the application and is accompanied by the fee set forth in 37 CFR 1.17(p) and the certification specified in 37 CFR 1.97(e) follows.

- ☐ [] The undersigned counsel for applicant(s) hereby certifies each item of information contained in the accompanying Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the Information Disclosure Statement.
- ☐ [] The undersigned counsel for applicant(s) hereby certifies that no item of information contained in the accompanying Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the undersigned, after making reasonable inquiry, no item of information contained in the accompanying Information Disclosure Statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the Information Disclosure Statement.
- ☒ [X] A copy of a Search Report from a corresponding foreign patent application (Japanese Patent Application No. 09-305612) is enclosed.
- ☐ [] A check in the amount of \$180 to cover the required fee is enclosed.
- ☐ [] The Commissioner is hereby authorized to charge the amount of \$180 to cover the required fee to Deposit Account No. 02-1818.
- ☒ [X] The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 02-1818.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY


Thomas C. Basso
Reg. No. 46,541
Customer No. 29175

Dated: January 30, 2007

The submitted reference was prepared by a foreign Patent Office, and is directed to a foreign counterpart application to the present US Patent Application. Consistent with Applicant's duty of disclosure under 37 CFR 1.56, Applicant recognizes that the Examiner may consider it relevant when making a patentability determination. However, this submission should not be misconstrued as an admission by the Applicant that the reference is either relevant or not relevant to patentability, especially since the reference was prepared by a foreign Patent Office that is governed by a different body of law than the USPTO.

Nevertheless, in the interest of full disclosure and good faith, Applicant submits the reference for consideration by the Examiner, and requests that the Examiner initial the attached Form PTO 1449, indicating the Examiner has considered this reference.

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Notification of Reasons for Refusal

Patent application number 1997-305612
Drafting date September 5, 2006
Examiner Ako Shuichiro 3145 5B00
Representative of the applicant Waki Atsuo (one other partner)
Applicable articles the body of Article 29; Article 36

This application should be refused according to the following reasons. If there are any opinions concerning this refusal, please file an argument within 60 days from the transmittal date of this notification.

Reasons

1. For this application, the description of the claims does not satisfy the requirements prescribed in article 36, paragraph 6, item 2 of the Patent Law in the following points.

Note

(1) It is not clear what kind of information is specifically referred to by the text, "the information saved in said recording media" in claim 1. In addition, a relationship between the information and "download ID information" is not clear.

The same applies to claim 17.

(2) In the text, "a confirm process for use conditions using the information saved in said recording media" and "a download process of predefined information for said recording

media based on download ID information" in claim 1, it is not clear how to specifically use "the information saved in said recording media" and "download ID information".

The same applies to claims 2, 3, 5, 6, and 17 – 19.

(3) In connection with the above mentioned reason 1. (2), it is not clear what kind of process is specifically referred to by the underlined text in "regarding said download process or said confirm process for use conditions when using said download terminal, necessary information communication is executable between said download terminal and said server system" in claim 1.

(4) In connection with the above mentioned reason 1. (3), in the text, "it is done by communicating serial number information, user ID information, and password information

P. 2

between said download terminal and said server system" in claim 7, it is not clear where (in other words, which of the "download terminal" or the "server system") and how the communicated "serial number information, user ID information, and password information" are utilized.

(5) In the text, "the transfer means to transfer the input means between a usable state and an unusable state" in claim 14, it is not clear what is referred to – or what kind of thing is specifically referred to – by the "transfer means" for transferring something between a "state" and a "state".

The same applies to claim 26.

(6) It is not clear what kind of information is specifically referred to by the text, "information used for download use" in claim 16. In addition, a relationship between the information and "the information saved in said recording media"/"download ID information" in claim 1 referred by claim 16, is not clear.

Therefore, the invention relating to claims 1 – 26 is not clear.

2. Because the invention relating to the following claims in this application does not satisfy the requirements prescribed in the body of article 29, paragraph 1 of the Patent Law in the following points, the right to the patent shall not be granted.

Note

While the invention relating to claims 27 – 29 in this application is regarding a recording media used by a download system, because in the recording media, only a data structure stored in the recording media has a characteristic, and the data structure itself is based only on a man-made arrangement, it does not utilize the law of nature. Furthermore, because it cannot be said that the information processing using the data stored in the recording media is achieved specifically by using hardware resources, the invention

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Application Number	10016242
Filing Date	2001-10-30
First Named Inventor	Shigeru Yokono et al.
Art Unit	2155
Examiner Name	Philip B. Tran
Attorney Docket Number	112857-250

U.S. PATENTS

Examiner Initial*	Cite No	Patent Number	Kind Code ¹	Issue Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
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U.S. PATENT APPLICATION PUBLICATIONS

Examiner Initial*	Cite No	Publication Number	Kind Code ¹	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear
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FOREIGN PATENT DOCUMENTS

Examiner Initial*	Cite No	Foreign Document Number ³	Country Code ² i	Kind Code ⁴	Publication Date	Name of Patentee or Applicant of cited Document	Pages, Columns, Lines where Relevant Passages or Relevant Figures Appear	T ⁵
	1	62-74194	JP		1987-04-04			<input type="checkbox"/>
	2	63-317893	JP		1988-12-26			<input type="checkbox"/>
	3	2-1090	JP		1990-01-05			<input type="checkbox"/>

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Filing Date		2001-10-30
First Named Inventor		Shigeru Yokono et al.
Art Unit		2155
Examiner Name		Phillip B. Tran
Attorney Docket Number		112857-250

4	4-109191	JP	1992-01-14	<input type="checkbox"/>
5	4-64129	JP	1992-02-28	<input type="checkbox"/>
6	8-255194	JP	1996-10-01	<input type="checkbox"/>
7	9-167179	JP	1997-06-24	<input type="checkbox"/>

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NON-PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc), date, pages(s), volume-issue number(s), publisher, city and/or country where published.	T ⁵
	1		<input type="checkbox"/>

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EXAMINER SIGNATURE

Examiner Signature	Date Considered
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ See Kind Codes of USPTO Patent Documents at www.USPTO.GOV or MPEP 901.04. ² Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). ³ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁴ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁵ Applicant is to place a check mark here if English language translation is attached.

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Not for submission under 37 CFR 1.99)

Filing Date	2001-10-30
First Named Inventor	Shigeru Yokono et al.
Art Unit	2155
Examiner Name	Philip B. Tran
Attorney Docket Number	112857-250

CERTIFICATION STATEMENT

Please see 37 CFR 1.97 and 1.98 to make the appropriate selection(s):

☐ That each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(1).

OR

☐ That no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in 37 CFR 1.56(c) more than three months prior to the filing of the information disclosure statement. See 37 CFR 1.97(e)(2).

☐ See attached certification statement.

☐ Fee set forth in 37 CFR 1.17 (p) has been submitted herewith.

☒ None

SIGNATURE

A signature of the applicant or representative is required in accordance with CFR 1.33, 10.18. Please see CFR 1.4(d) for the form of the signature.

Signature	Date (YYYY-MM-DD)	2007-01-30
Name/Print	Registration Number	46541

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**